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Docket
508-04

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED

In re application of

Docket No: Q55129

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Hideya TAKEO

Technology Center 2600

Appln. No.: 09/356,505

Group Art Unit: 2623

Confirmation No.: 7922

Examiner: Anand P. BHATNAGAR

Filed: July 19, 1999

For: METHOD, APPARATUS AND RECORDING MEDIUM FOR DATA COMPRESSION

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
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Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated August 11, 2003. Entry of this Reply Brief is respectfully requested.

POINTS RAISED IN EXAMINER'S ANSWER

A. Grouping of Claims

The Examiner initially asserts that claims 1-30 stand or fall together "because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof." *See Examiner's Answer, page 2.* The Examiner's assertion is incorrect. In its Appeal Brief, Appellant stated:

For each ground of rejection, the claims stand or fall together. Accordingly the claims should be considered in two groups:

Group I: 1-3, 5-12, 16-18 and 22-30

Group II: 4, 13, and 19

See Appeal Brief, page 5.

Accordingly, contrary to the Examiner's assertion, Appellant properly grouped the claims and stated that the claims stand or fall together based individually on the two grounds of rejection. Therefore, claims 1-3, 5-12, 16-18 and 22-30 stand or fall together and claims 4, 13, and 19 stand or fall together.

Furthermore, additional arguments were provided in regard to claims 4, 13 and 19 related to the alleged obviousness to combine the teachings of the references. Thus, Appellant has provided sufficient reasons in support of its grouping of claims.

B. Examiner's Response to Appellant's Arguments

In an attempt to explain the deficiencies of the teachings of the cited references, the Examiner is now attempting to change the game. The Examiner now takes the unsupported position that the claims do not require classifying the quantized data into three data types. In doing so, the Examiner admits that the Kolesnik reference only teaches classifying the quantized data into two types. *See Examiner's Answer, page 10.* However, the Examiner's new position is that “[n]owhere in the claims does it state that the quantized data is broken down into three sets of data because it does not claim that the classification information is obtained from the quantized data.” *Id. at page 11.* The Examiner new position is not supported by the claims, specification, or any previous arguments.

Appellant would first like to point out that the Examiner has never previously taken the position that the claims do not recite that “the quantized data is broken down into three sets of data.” In each of Appellant’s responses to the Examiner’s office actions, the Appellant has argued that the claims recite that the data subject to quantization (e.g. quantized data) is classified into three types of data. *See Appellant’s Amendment under 37 C.F.R. § 1.111, pages 8-9; Appellant’s Amendment under 37 C.F.R. § 1.116, page 4.* In response to each of these amendments, the Examiner failed to argue that the claims did not recite classifying quantized data into three types. In fact, in the Advisory Action of March 24, 2003, the Examiner attempts to explain where the three types of data are disclosed in Kolesnik. *See Advisory Action, continuation sheet (“This is one of the three types of classification that Kolesnik discloses. The other two types are performed after the quantification step.”)(Emphasis added).* Accordingly, this is the first time that the Examiner has raised this argument and thus, this is the first opportunity that Appellant has had to address this argument. Only after the Examiner has realized the deficiencies in the cited references has the Examiner created this new position. However, if the Examiner truly believed this to be correct, then this could have and should have been brought to the Appellant’s attention earlier in the prosecution of this application.

Nevertheless, the claims actually recite that the quantized data is classified into three types. Looking at the relevant portion of claim 1:

classifying the quantized data into data having a value representing the quantized data and at least one set of classified data representing a data value other than the representative value while obtaining classification information data regarding the classification.

The claim, on its face, recites three types of data: 1) data having a value representing the quantized data; 2) data representing a data value other than the representative value; and 3) classification information data regarding the classification. Appellant submits that the claim is clear that three types of data are classified following the quantization of the original data. If any ambiguities existed in the Examiner's mind, as stated above, the proper time to address these ambiguities was in an office action. However, ambiguities in claim language must be considered in light of the specification. In light of the specification, it is clear that the claims require three types of classification of the quantized data.

For example, the classification of the quantized data into three data types is completely supported by the specification. The specification explains:

According to the present invention, the quantized data obtained by quantification of the original data are classified into the data having the representative value, the classified data, and the classification information data showing a classification result according to the data values.

Specification, page 9. The specification further explains:

...classification means 4 for obtaining 0 data s0, non-zero data NS and classification information data B representing a classification result through classification of the quantized data RS...

Id. at page 13, and that:

the quantized data RS are classified into the 0 data, the non-zero data NS, and the classification information data B representing information regarding this classification.

Id. at page 22.

It is abundantly clear that when the claims are read in light of the specification that the claims recite classification into three types.

Furthermore, based on the Examiner own admissions, the Kolesnik reference fails to disclose the recited classification types. Specifically, the Examiner states that “the ‘quantized reference coefficients are read as the quantized data other than the representative data’ as well as ‘classification information’ since the quantized reference coefficients are information regarding the quantized coefficient matrix.” *See Examiner’s Answer, page 10 (Emphasis added).*

Moreover, in an attempt to explain the double counting of the “quantized reference coefficients” as two of the data types, the Examiner explains that the application “does not claim that an element cannot have a dual purpose therefore examiner believes that the quantized reference coefficients can be read as two of the datas as claimed in the instant invention as discussed above.” *Id. at page 11.* In other words, the Examiner does not refute double counting elements, but instead attempts to justify the double counting by stating that the claims do not explicitly exclude double counting elements. However, each of these data types are independent from one another and contain discrete information. As the claims recite, the “classification information” and “quantized data other than the representative data” are coded in different manners by different coding means. Kolesnik does not even teach coding “classification information.” If the Examiner’s double counting were permitted, the claim could not be read upon because the same data would be coded by the first and second coding means. The Examiner’s interpretation is not supported by the specification and should not be permitted to stand.

Finally, the Examiner attempts to refute Appellant’s argument against the obviousness of the combination of Kolesnik and Nafarich by holding that it would have been obvious to combine these references because both references are “in the same art of data compression by

decomposing a signal, with different decomposition methods, into components followed by coding and compression.” *Id at pages 11-12.* In other words, the Examiner believes that it would be obvious to combine the teachings of the cited references because of the references are analogous art. However, the standard for whether it would have been obvious to combine the teaching of two references is not determined solely by the fact that the references are in the same art. Rather, to establish obviousness based on a combination of two references, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Without some motivation, suggestion or teaching of the desirability of making the claimed combination, a rejection under 35 U.S.C. § 103 is improper and must be reversed. *Id.* Here, the Examiner has not refuted Appellant’s factual explanation for why it would not have been obvious to combine the teachings of the two references, and has not provided any motivation, suggestion or teaching of the desirability of making the claimed combination. Therefore, the rejection under 35 U.S.C. § 103 is improper.

Based on the above remarks, Appellant requests that the Board reverse the rejection claims 1-3, 5-12, 16-18 and 22-30 under 35 U.S.C. § 102, and the rejection of claims 4, 13 and 19 under 35 U.S.C. § 103(a).

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CONCLUSION

For the above reasons as well as the reasons set forth in Appellant's Brief on Appeal, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,


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